

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/667,301

was not available due to it being granted an allowance and 2) the Applicant did not supply a translation of the document.

With respect to the Examiner's first reason for not considering the first foreign document, Applicant submits that the IDS was filed approximately one year and one month prior to the Examiner issuing the present Office Action. Applicant cannot understand how in this time, the corresponding U.S. application (U.S. Serial No. 09/390,290) was not available for the Examiner to inspect. Further, Applicant can find no reference either in the MPEP or 37 C.F.R. which excuses the Examiner from considering a document submitted over a year prior because the application was unavailable. Additionally, MPEP§ 609(B) states "[a]ll information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within 3 months of the filing date, including the filing date of a CPA, will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time." (Emphasis added). Since the Examiner has not alleged that the IDS does not comply with 37 C.F.R. §§ 1.97 or 1.98, under MPEP§ 609 "the examiner has an obligation to consider the information." (Emphasis added).

With respect to the Examiner's second reason for not considering the first foreign document, Applicant submits that a translation of the document is not required to be provided to the Examiner. According to 37 C.F.R. § 1.98, for documents submitted in a foreign language, the Applicant is require to provide an explanation of the relevance of the foreign language document. "The concise explanation may be either separate from the specification or incorporated therein." (Emphasis added). As explained in the Amendment filed on August 21, 2001, the concise explanation of relevance of this document is discussed on the first page of the

specification and provides sufficient information for the Examiner to consider the reference.

Therefore, Applicant respectfully submits that all of the requirements of 37 C.F.R. §§ 1.97 and 1.98 have been met with respect to the first foreign document, and consequently, Applicant requests that this document be considered by the Examiner as obligated under MPEP§ 609.

***B. Japanese Patent No. 2,658,811***

The Examiner maintains that the second foreign patent document (Japanese Patent No. 2,658,811) submitted in the September 25, 2000 IDS was not considered because it was not accompanied by an abstract. Applicant respectfully submits that an abstract of the second foreign patent document is not necessary in order to satisfy the requirements of 37 C.F.R. §§ 1.97 and 1.98 because these requirements have already been met. First, the concise statement of relevance of the second foreign patent document is provided on the first page of the specification and provides sufficient information for the Examiner to consider the reference. Second, in the IDS, Applicant stated that the second foreign patent document corresponds to U.S. Patent No. 5,556,098, which the Examiner has already considered. In response, the Examiner states that “[t]he Examiner does not have proof that it is indeed the same documents as the U.S. Patent and U.S. Serial No. stated in the IDS.” Besides that fact that Applicant explicitly represented in the IDS and the Amendment of August 21, 2001 that the second foreign patent document corresponds to U.S. Patent No. 5,556,098, Applicant submits that further proof may be found in the documents themselves.<sup>1</sup> As shown on the first page of U.S. Patent No. 5,556,098, the patent

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<sup>1</sup> Applicant has attached to this Response the first pages of U.S. Patent No. 5,556,098 and Japanese Patent No. 2,658,811.

claims priority from Japanese Application No. 5-193064.<sup>2</sup> Further, as shown on the first page of the second foreign patent document (Japanese Patent No. 2,658,811)<sup>3</sup>, the application number of the second foreign patent document is 5-193064. Applicant submits that the explicit representations made that the second foreign patent document corresponds to U.S. Patent No. 5,556,098 are supported by the documents themselves, from which the Examiner should have more than a sufficient amount of information available to consider second foreign patent document. As such, Applicant respectfully requests that the second foreign patent document be considered by the Examiner.

Applicant would also respectfully request that if the Examiner, in light of the above remarks, believes that the IDS of September 25, 2000 does not comply with the federal rules or MPEP, the Examiner state with particularity which federal rule or MPEP section is not satisfied and why it is not satisfied.

## **II. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 1 and 4-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuchi et al. (U.S. Patent No. 5,830,085) in view of OFFICIAL NOTICE. To establish a prima facie case of obviousness the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. See MPEP § 2143. Applicant respectfully submits that the references cited above by the Examiner fail to teach or suggest all of the claim

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<sup>2</sup> See highlighted and circled portion of attached U.S. Patent No. 5,556,098.

<sup>3</sup> See highlighted and circled portion of attached JP Patent No. 2,658,811.

limitations as set forth in the present application. Specifically, the cited reference, as well as the official notice, fails to teach or suggest a compression ratio of 0.98.

The compression ratio of 0.98 separates the synthetic effects from general effects of golf balls. Specifically, when the compression ration is more than 0.98, the golf balls have a good feel when hit with various types of clubs and improved distance when struck with a driver. Please see the results shown in Table 3 of the present specification. The boundary between Example 4 and Comparative Example 1 is whether or not at least one rating of either “Fair” or “Poor” exists relating to the flying performance test and feel tests. The results of Table 3 illustrate that flying performance of the driver (HS=40) is improved, and the feel of various types of clubs become good so long as the compression ratio of the golf balls is set in the claimed range of at least 0.98. The users of golf balls generally play golf on a golf course using a variety of types of clubs. Particularly, it is noted that a driver (W#1), #9 iron and putter are essential clubs among the various types of clubs.

As discussed on page 9 of the specification, ten golfers with a clubhead speeds ranging from 35 m/s (HS35) to 45 m/s (HS45) actually hit golf balls and rated the performance of the golf balls as follows:

VG: Very good- More than nine golfers felt soft and good.

Good: Good, soft feel- Six to eight golfers felt soft and good.

Fair: Somewhat hard- Two to five golfers felt soft and good. (Conversely, five to eight golfers felt slightly hard.)

Poor: Hard- More than nine golfers felt not soft and good.

Specifically, when the boundary “0.98” of the compression ratio is not exceeded, a half of golfers do not satisfy the feel test of the golf balls. It is noted that the boundary “0.98” of the compression ratio is an important factor to exhibit the improved flying performance of the driver and the feel of various types of clubs (particularly, a driver, No. 9 iron and a putter). Thus, the golf balls of the present invention particularly exhibit remarkable feel effects using three essential clubs. The present inventors have found the significance of “0.98” of the compression ratio which is a boundary between remarkable effects of claimed golf balls and general effects of golf balls. Said differently, golf balls having a compression ratio, defined as (compression of mantle)/(compression of solid core), of at least 0.98, display remarkable effects as compared to golf balls having a compression ratio below 0.98. Thus, there is a recognized significance of the compression ratio being at least 0.98.

As the Examiner has acknowledged, Higuchi et al. does not teach or suggest the required compression ratio of the claimed range. To compensate for the inadequate teachings of Higuchi, the Examiner takes Official Notice that deformation is directly related to the modulus of elasticity ( $E = \text{load} / \text{amount of deformation}$ ), and consequently affects the golf balls’ restitution. Further, the Examiner asserts that it would have been obvious to provide a golf ball taught by Higuchi with a compression ratio of 0.98 in order to optimize the resiliency, restitution and hitting feel of the golf ball. The Examiner’s assertion is flawed and based purely on impermissible hindsight. First, neither Higuchi or the Examiner’s Official Notice recognize the significance of the compression ratio, and more particularly, neither recognize the significance on the boundary of 0.98. The Examiner appears to believe that it would have been obvious to optimize the compression ratio of Higuchi because the modulus of elasticity affects the golf

ball's resiliency, restitution and hitting feel. Yet nothing relied on by the Examiner suggests that the ratio of the compression of the mantle to the core affects the performance of the golf ball. However, a "particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable range of said variable might be characterized as routine experimentation." MPEP §2144.05(II)(B), citing In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977), In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Since neither Higuchi or the Official Notice recognize the compression ratio as being a result-effective variable, the Examiner cannot now rely on optimizing Higuchi to cure its deficient teachings with respect to claim 1.

Furthermore, the only document of record which recognizes the compression ratio as being a result-effective variable is the Applicant's own specification. Only there was it discovered that by adjusting the compression ratio of the mantle and the core, could the performance of the golf ball be improved as hit with a plurality of essential golf clubs. However, the Examiner is required to forget what he has been taught about the claimed invention and to cast his mind back to the time the invention was made, to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984), and MPEP §2141.01. If there is no teaching, suggestion, or motivation, either in the references, then there is no suggestion or motivation to modify the references to achieve the claimed limitations of the present invention, and the Examiner is engaging in impermissible hindsight in stating that the claims are obvious over the applied prior art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re

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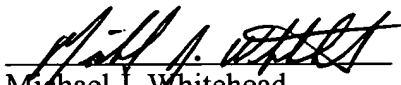
Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and MPEP §2143.01. Since the relied upon references do not remotely discuss the ratio of the compression of the mantle to the compression of the core, Applicant submits that the Examiner is engaging in impermissible hindsight. Furthermore, Applicant has already provided evidence in the Amendment filed on August 21, 2001 that golf ball made according to the Higuchi patent do not fall within the bounds of claim 1. Therefore, Applicant respectfully requests that the rejection of claim 1, and claims 4-16 by virtue of their dependency from claim 1, be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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Date: January 28, 2002